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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------|------------------------|
| 10/705,627 | 11/10/2003 | Wen San Chou | 14039 B | 4788 |
| 36672 7590 09/17/2007 CHARLES E. BAXLEY, ESQ. 90 JOHN STREET THIRD FLOOR NEW YORK, NY 10038 | | | EXAMINER HAMO, PATRICK | |
| | | | ART UNIT 3746 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/705,627 | Applicant(s) CHOU, WEN SAN | |
| | Examiner Patrick Hamo | Art Unit 3746 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to amendments filed on July 12, 2007.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chou, Pat. No. 6,095,758 in view of Luo, Pat. No. 5,411,379

.Chou discloses an air compressor comprising a base 1 including an aperture 1F formed in an upper portion thereof and including an orifice 12 formed in a lower portion thereof, and including an opening 10 formed in a front portion of the base, the front being the side of the base in view in fig. 1, and defined by a peripheral flange 101 and communicating with the orifice and for forming a peripheral shoulder (the portion of the base 1 defined by the flange against which the sleeve 14 is seen to abut in the cross-sectional view of fig. 4) between the orifice and the opening of the base, a sleeve 14 engaged in the opening of the base and retained in the opening of the base with the peripheral shoulder and peripheral flange of the base (fig. 4), an eccentric member 20 including a shaft 21 extending therefrom, and rotatably engaged through the sleeve and rotatably secured to the base with the sleeve, the eccentric member including a pin 24

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extended therefrom and eccentric relative to the shaft, a fastener 26 securing the shaft to the sleeve, a cylinder 17 including a piston rod 30 rotatably coupling to the pin of the eccentric member through link 34, a gear 22 attached to the eccentric member, the gear including a chamber 2A formed therein and defined by a peripheral casing formed by two bars or shoulders extending from the gear (col. 3, ll. 4-7) to receive the eccentric member, the gear and the eccentric member being rotated in concert with each other and being rotatable relative to the base about the shaft of the eccentric member, and a motor 15 secured to the base via screw rods 13 and including a pinion 16 provided thereon and engaged with the gear to rotate the gear and eccentric member relative to the base (fig. 4) and to move the piston rod in the cylinder in a reciprocating motion (col. 3, l. 66 – col. 4, l. 3).

Chou does not disclose a bearing engaged in the opening of the base and retained in the opening of the base with the peripheral shoulder and peripheral flange of the base, the shaft of the eccentric member rotatably engaged through the bearing and rotatably secured to the base with the bearing, nor a fastener securing the shaft to the bearing. Instead, as discussed above, Chou discloses a sleeve 14 retained in the opening against the flange and shoulder, the shaft 21 of the eccentric member 20 rotatably engaged through the sleeve, in the position which the present application claims a bearing.

However, it is common in the art to provide a bearing between a rotating shaft and a stationary part such as the base in the present application in order to properly align the shaft and reduce friction associated with its rotation. Luo discloses a motor-

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driven pneumatic fan with a plurality of bearings 51 and 71 disposed between a rotating shaft (reference numeral 6 in fig. 2, reference numeral 16 in fig. 3 and the specification) and stationary seats 50 and 70, respectively.

Because both Chou and Luo disclose means of rotatably securing a rotating shaft to a stationary base part, it would have been obvious to substitute the bearing assembly of Luo for the sleeve of Chou in order to achieve the predictable result of aligning the shaft and reducing friction associated with its rotation.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,095,758 in view of Brown et al., Pat. No. 6,296,765.

Claim 1 of Patent No. 6,095,758 discloses most of the limitations of claim 1 in the present application, including a securing seat (corresponding to the base in the present application) including a slot (opening) communicating with a shaft receiving hole (orifice), two opposite planar portions (peripheral flanges), projecting rim (peripheral shoulder), a motor with a main gear (pinion), a weight (eccentric member) with a shaft and connecting rod (pin) extending therefrom, a piston coupled to the pin, a gear attached to the weight, an E-shaped fastening clip, a receiving recess (chamber) in the gear, and retaining blocks (peripheral casing) to hold the weight in place in the gear (col. 4, l. 26 – col. 6, l. 22).

As discussed above in the rejection under 35 USC 103(a), Patent No. 6,095,758 does not disclose a bearing engaged in the opening of the base and retained in the opening of the base with the peripheral shoulder and peripheral flange of the base, the shaft of the eccentric member rotatably engaged through the bearing and rotatably secured to the base with the bearing, nor a fastener securing the shaft to the bearing. Instead, as discussed above, Chou discloses a sleeve 14 retained in the opening against the flange and shoulder, the shaft 21 of the eccentric member 20 rotatably engaged through the sleeve, in the position which the present application claims a bearing.

However, it is common in the art to provide a bearing between a rotating shaft and a stationary part such as the base in the present application in order to properly align the shaft and reduce friction associated with its rotation. Luo discloses a motor-driven pneumatic fan with a plurality of bearings 51 and 71 disposed between a rotating shaft (reference numeral 6 in fig. 2, reference numeral 16 in fig. 3 and the specification) and stationary seats 50 and 70, respectively.

Because both Chou and Luo disclose means of rotatably securing a rotating shaft to a stationary base part, it would have been obvious to substitute the bearing assembly of Luo for the sleeve of Chou in order to achieve the predictable result of aligning the shaft and reducing friction associated with its rotation.

Response to Arguments

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that the prior cited art failed to teach a compact air compressor comprising a base including an opening formed by a peripheral flange and a peripheral shoulder formed between an orifice and the opening of the base for stably receiving the bearing and for engaging with a shaft of an eccentric member in order to smoothly couple the shaft of the eccentric member to the base and to prevent the shaft of the eccentric member from becoming loose relative to the base and thus to prevent great noise from being generated between the shaft of the eccentric member and the base, and also to prevent a great heat from being generated between the shaft and the base. However, it is noted that the features upon which applicant relies (i.e., the intended use features) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, in response to applicant's argument that the bearings reduce noise, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references teach the use of bearings on motor shafts for the purpose of friction reduction:

Patent Nos. 6,892,431; 6,688,865; 6,688,859; 6,659,060; 6,530,760; 6,490,905; 6,409,507; 6,308,748; 5,775,275; 5,595,251; 5,209,190; 5,152,254; 4,838,114; 4,828,403; 4,236,496; 3,746,475.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Hamo whose telephone number is 571-272-3492. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature consisting of the letters 'PH' in a stylized, cursive script.

PH

A handwritten signature in cursive script, appearing to read 'Anthony Stashick'.

Anthony Stashick
Supervisory Patent Examiner
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